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09/888,446	06/26/2001	Shozo Onmori	Q63872	9704

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EXAMINER
CAO, ALLEN T

ART UNIT	PAPER NUMBER
2652	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/888,446	Applicant(s) ONMORI ET AL.	
	Examiner Allen T Cao	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4 and 6-26* is/are rejected.

7)☒ Claim(s) *2 and 5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Claims 17-20 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The phrase "fitting other members" in claim 17 is vague and indefinite because what are "other members" and where its located?

b) The term "method" in claim 26 is vague and indefinite because this claim is an apparatus claim, not a method claim.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 4 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bardmesser (US. 5,986,992).

Bardmesser discloses a recording medium cartridge defined as a magnetic tape cartridge having a cartridge case, constructed of upper and lower halves, for accommodating a recording medium; a slider, so fitted as to slide on a bottom surface of the lower half; and a non contact type memory device 8 provided in a recessed portion formed in at least one of the bottom surface of the lower half and an upper surface of the slider (see figures 13-14b) as set forth in claims 4 and 6-7.

4. Claims 10-12, 21-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al (US. 5,896,256).

Lang et al disclose a recording medium cartridge having a cartridge case for accommodating a recording medium including a transparent window 12 that is visually recognizable; and a cartridge memory (4, figures 3 and 4) provided in the transparent window for recording information on the recording medium cartridge and information on data recorded on the recording medium as set forth in claims 10-11, 21-24 and 26.

Regarding claim 12, Lang et al inherently disclose that the cartridge memory is attached to a rear side of the transparent window (the memory member attached on the window which inherently included on the rear side on the window).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 8-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US. 5,896,256).

Lang et al disclose a recording medium cartridge having a case body constructed by joining an upper half and a lower half to each other; a slider 5 having engagement slide members provided at both side ends thereof and slidably inserted into slide grooves formed, extending in front and rear directions of the cartridge body, between right/left side walls of the upper half and

right/left side walls of the lower half, and fitted along the bottom surface and the side surface of the lower half ; and a cartridge memory (see figure 3 and abstract) provided a side of the slider for recording information on the recording medium cartridge and information on data recorded on the recording medium (column 3, lines 60-65) as set forth in claims 8, 15 and 17.

Regarding claims 9, 16 and 18, Lang et al disclose the cartridge memory is disposed on an internal surface of a recording medium turn preventive rib within the cartridge.

Lang et al do not disclose that the memory is provided in the slider as recited in claims 8-9 and 15-18.

However, Lang et al teaches that "... the access opening 4 and the capacity indicator 10 need not be located towards the peripheral edge of the cartridge 3 where the cover plate 6 is located but instead may be located elsewhere on the cartridge 3 ..." (See column 5, lines 55-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to relocate the cartridge memory of Lang et al with the location as set forth, supra as taught in column 5, lines 55-58 of Lang et al.

The rationale is as follows: One of ordinary skill in the art would have been motivated to relocate the cartridge memory of Lang et al with the location as set forth, supra as taught in column 5, lines 55-58 of Lang et al through an obvious relocate the parts which is not a critical of the invention.

Regarding claims 17 and 18, Lang et al do not teach that the cartridge memory is welded together when fitting "other members".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a welded method to fitting the memory member of Lang et al with "other members" as claimed as a result of routine engineering optimizing. Applicant has shown no criticality for such as any unexpected results deriving from such. Additionally, appellants' argument, however, is not found to be persuasive as a process limitation should only be accorded weight to the extent that it affects the structure of the completed thin film magnetic head since claims are directed to a "thin film magnetic head", per se. Furthermore, it should be noted that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior art product was made by a different process", In re Thorpe, et al., 227 USPQ 964 (CAFC 1985). It should also be noted that a "[p]roduct-by process claim, although reciting subject matter of claim in terms of how it is made, is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations", In re Hirao and Sato, 190 USPQ 685 (CCPA 1976).

7. Claims 13-14, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al in view of Bardmesser.

Lang et al do not disclose that the memory is so fitted as to be set in a notch formed in a sheet positioning rib provided on the recording medium cartridge as recited in claims 13-14, 20 and 25.

Bardmesser discloses that the memory is so fitted as to be set in a notch formed in a sheet positioning rib provided on the recording medium cartridge (see rejection of claim 9 as set forth, above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cartridge of Lang et al such that the memory is so fitted as to be set in a notch formed in a sheet positioning rib provided on the recording medium cartridge as taught by Bardmesser through an obvious relocate the parts which is not a critical of the invention.

8. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardmesser in view of Lang et al.

Bardmesser discloses a recording medium cartridge defined as a magnetic tape cartridge having a cartridge case, constructed of upper and lower halves, for accommodating a recording medium; a slider, so fitted as to slide on a bottom surface of the lower half; and a non contact type memory device 8 provided in a recessed portion formed in at least one of the bottom surface of the lower half and an upper surface of the slider (see figures 13-14b) as set forth in claim 1.

Bardmesser does not disclose that the memory member is disposed in a reel as claimed.

Lang et al disclose a recording medium cartridge having a case body constructed by joining an upper half and a lower half to each other; a slider 5 having engagement slide members

provided at both side ends thereof and slidably inserted into slide grooves formed, extending in front and rear directions of the cartridge body; and a cartridge memory (see figure 3 and abstract) provided a side of the slider for recording information on the recording medium cartridge and information on data recorded on the recording medium (column 3, lines 60-65).

Lang et al also teach that "... the access opening 4 and the capacity indicator 10 need not be located towards the peripheral edge of the cartridge 3 where the cover plate 6 is located but instead may be located elsewhere on the cartridge 3 ..." (See column 5, lines 55-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to relocate the cartridge memory of Bardmesser with the location as set forth, supra as taught in column 5, lines 55-58 of Lang et al.

The rationale is as follows: One of ordinary skill in the art would have been motivated to relocate the cartridge memory of Bardmesser with the location as set forth, supra as taught in column 5, lines 55-58 of Lang et al through an obvious relocate the parts which is not a critical of the invention.

Regarding claim 3, Bardmesser as modified by Lang et al do not teach that the cartridge memory is attached to the reel by an adhesive agent or by insert molding when molding parts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a adhesive or molding method to fitting the memory member of Bardmesser as modified by Lang et al with the reel as claimed as a result of routine engineering optimizing. Applicant has shown no criticality for such as any unexpected results deriving from such.

Additionally, appellants' argument, however, is not found to be persuasive as a process limitation should only be accorded weight to the extent that it affects the structure of the completed thin film magnetic head since claims are directed to a "thin film magnetic head", per se. Furthermore, it should be noted that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior art product was made by a different process", In re Thorpe, et al., 227 USPQ 964 (CAFC 1985). It should also be noted that a "[p]roduct-by process claim, although reciting subject matter of claim in terms of how it is made, is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations", In re Hirao and Sato, 190 USPQ 685 (CCPA 1976).

9. Claims 2 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Cao whose telephone number is (703) 305-3796.

Allen Cao

Primary Examiner

AC

June 30, 2003